

REMARKS

Applicant has reviewed the Final Office Action dated August 3, 2006 (hereinafter “Office Action”), and the references cited therewith.

Claims 1, 8, 9, 17, and 25 are currently amended. Claim 7 has been previously canceled. No claims are added. As a result, claims 1-6 and 8-26 are now pending in this application. Applicant submits that the amendments to the claims are fully supported by the application as originally filed, and no new matter has been added.

Applicant hereby respectfully requests further examination and reconsideration of the application in view of the following remarks.

§112 Rejection of the Claims

Claims 1-23 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Applicant has amended claims 1 and 8. In addition, Applicant directs attention to page 7, lines 11-17 and the figures referenced therein, which provide a recitation of how the fixation helix in conjunction with the piston forms a drive mechanism.

§102 Rejection of the Claims

Claims 1-2, 8-10, 12, 14-17, and 25 were rejected under 35 U.S.C. § 102(b) as being anticipated by Li (U.S. Patent No. 5,259,395). Claims 1-6, 8-9, 11-14, and 19-23 were rejected under 35 U.S.C. § 102(b) as being anticipated by Bisping (U.S. Patent No. 4,282,885). Applicant respectfully traverses such rejections.

To establish a case of anticipation, a single reference which teaches or enables each of the Applicant’s claimed elements and/or limitations (arranged as in the claim) expressly or inherently as interpreted by one of ordinary skill in the art must be provided. (*See W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983)(stating “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration); *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730

F.2d 1452, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984)(indicating “[i]n deciding the issue of anticipation, the trier of fact must identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference”); and *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)(adding “[t]here must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention”).

Claims 1-2 (In Light of Li):

Applicant submits that not all of the elements and/or limitations of claims 1-2 can be found in the cited reference (Li), as required by *W.L. Gore & Associates*.

Claim 1:

Applicant cannot find in the cited portions of Li, “[a] lead assembly comprising . . . a fixation helix supported by the piston at a first portion of the fixation helix, the first portion of the fixation helix supported by the piston forming a drive mechanism including one or more helical drive grooves; and a housing portion disposed near the distal end of the lead body, the housing portion including a guide disposed on an inner surface thereof and rideable within the helical drive grooves allowing at least one of advancing or retracting of the fixation helix relative to the lead body,” as recited in claim 1. Rather, Li recites “[a]s illustrated, the rotor body 40 [i.e., the asserted piston] is cylindrically shaped and preferably includes a helical groove 70 that includes a predetermined number of turns about the outer curved surface of the rotor body 40 . . . [perpendicular to the outer curved surface,] [t]he fixing helix 18 is secured on a distal end of the rotor body 40 . . . [i]t can [] be appreciated that due to the helical groove 70 and guide pin 72 or guide screw 74 arrangement, the rotor body 40 will rotate through a predetermined number of turns and will travel axially.” (Column 5, lines 1-4 and 40-41; column 6, lines 13-17). In brief, axial movement of the fixation helix in Li does not rely on one or more helical drive grooves formed by the fixation helix and its juncture with the piston as claimed by Applicant; but rather, Li relies on the helical groove about the outer surface of the rotor body in conjunction with the

guide pin or guide screw. Unlike Applicant's claim 1, the helical groove on the outer surface of the rotor body of Li is not the result of the fixation helix and its juncture with the rotor body.

In view of the fact that not all elements and/or limitations of Applicant's claim 1 can be found in Li, Applicant respectfully requests withdrawal of this basis of rejection of claim 1. Claim 2 is dependent on claim 1 and is patentable over Li for the reasons stated above, in addition to the elements and/or limitations in such claim.

Claims 8-10, 12, 14, and 25 (In Light of Li):

Applicant submits that not all of the elements and/or limitations of claims 8-10, 12, 14, and 25 can be found in the cited reference (Li), as required by *W.L. Gore & Associates*.

Claim 8:

Applicant cannot find in the cited portions of Li, "[a] lead assembly comprising . . . a housing disposed near the distal end of the lead body, the housing including a guide disposed on an inner surface thereof; . . . and a fixation helix coupled with the piston along a first longitudinal portion of the fixation helix, the first portion of the fixation helix coupled with the piston forming a drive mechanism that rides along the guide allowing at least one of advancing or retracting of the fixation helix relative to the lead body," as recited in claim 8. To this end, Applicant hereby incorporates by reference the relevant arguments asserted above with respect to claim 1 (i.e., axial movement of the fixation helix in Li does not rely a drive mechanism formed by the fixation helix coupled with the piston riding along a housing guide to advance or retract the fixation helix as claimed by Applicant; but rather, Li relies on the helical groove about the outer surface of the rotor body in conjunction with the guide pin or guide screw for axial movement of the distally positioned fixation helix). Unlike Applicant's claim 8, the helical groove on the outer surface of the rotor body of Li is not the result of the fixation helix and its coupling with the rotor body.

In view of the fact that not all elements and/or limitations of Applicant's claim 8 can be found in Li, Applicant respectfully requests withdrawal of this basis of rejection of claim 8. Claims 9-10, 12, 14, and 25 are dependent on claim 8 and are patentable over Li for the reasons stated above, in addition to the elements and/or limitations in such claims.

Claim 9:

In addition to the foregoing grounds set forth supporting the patentability of Applicant's claims 8-10, 12, 14, and 25 (of which claim 9 is included), Applicant cannot find in the cited portions of Li a lead assembly "wherein the guide is a helical guide protruding from the inner surface of the housing." Rather, Li recites "it is possible to realize an embodiment of the invention wherein a helical groove is provided on the inner surface of the sleeve and one or more guide pins are provided on the rotor body." (Column 6, lines 62-66). In brief, the guide of Li comprises a groove; whereas, claim 9 recites "a helical guide protruding from the inner surface of the housing."

In view of the fact that not all elements and/or limitations of Applicant's claim 9 can be found in Li, Applicant respectfully requests withdrawal of this basis of rejection of claim 9.

Claim 14:

In addition to the foregoing grounds set forth supporting the patentability of Applicant's claims 8-10, 12, 14, and 25 (of which claim 14 is included), Applicant cannot find in the cited portions of Li a lead assembly "wherein the fixation helix is electrically coupled with the conductor," as recited in claim 14. The Office Action asserts such claimed subject matter may be found at column 4, lines 15-18 of Li. (Office Action, page 3). Applicant points out that lines 15-18 of column 4 in Li recite "[a]s is further illustrated, other major components of the lead 14 include a fixed block 34, an electrical conductor 36 interconnecting the source of electrical energy and the electrical sleeve 32, a rotor body 40, a torsion spring 42, and the fixing helix 18." That is, Li recites that the electrical sleeve is electrically coupled with the electrical conductor; however, Applicant cannot find any recitation in Li that the helix therein is electrically coupled with the conductor as claimed. In fact, Applicant submits that the language of Li appears to indicate no need for the fixation helix to be electrically coupled with the conductor as the sleeve comprises a distal electrode contact. For instance, Li recites "[t]he distal tip of the lead 14 [] is formed by the exposed portion of the sleeve 32 so that good electrode contact can be had between the sleeve 32 and the body tissue." (Column 4, lines 32-35).

In view of the fact that not all elements and/or limitations of Applicant's claim 14 can be found in Li, Applicant respectfully requests withdrawal of this basis of rejection of claim 14.

Claim 25:

In addition to the foregoing grounds set forth supporting the patentability of Applicant's claims 8-10, 12, 14, and 25 (of which claim 25 is included), Applicant cannot find in the cited portions of Li a lead assembly "further comprising a stop adapted to prevent over extension of the fixation helix from the lead body, the stop protruding around a portion of the piston," as recited in claim 25. Rather, Li recites "[a]s illustrated most clearly in FIG. 2, a longitudinal groove 78 cuts through the helical groove 70 and terminates on the distal end in a catch 76." (Column 5, lines 16-18).

In view of the fact that not all elements and/or limitations of Applicant's claim 25 can be found in Li, Applicant respectfully requests withdrawal of this basis of rejection of claim 25.

Claims 15-17 (In Light of Li):

Applicant submits that not all of the elements and/or limitations of claims 15-17 can be found in the cited reference (Li), as required by *W.L. Gore & Associates*.

Claim 15:

Applicant cannot find in the cited portions of Li, "[a] lead assembly comprising . . . a piston electrically coupled with the conductor; an active fixation helix supported by the piston at a first portion of the fixation helix, the first portion of the fixation helix supported by the piston forming a drive mechanism that longitudinally advances and retracts the fixation helix; and a housing including a guide therein, the guide extending from an inner surface of the housing and adapted to interact with the first portion of the fixation helix," as recited in claim 15. The Office Action asserts that Li discloses a piston electrically coupled with a conductor at column 4, lines 15-18; however, Applicant points out that such lines of Li recite an electrical coupling between an electrical conductor and an electrical sleeve, but not between the conductor and the rotor body. (Office Action, page 3; Li, column 4, lines 15-18). In addition, Applicant cannot find any recitation in Li that the rotor body comprises an electrically conductive material enabling an electrical coupling to be made with the same.

The Office Action further asserts that Li discloses a guide adapted to interact with a first portion of a fixation helix at Figures 2-3; however, Applicant points out that in contrast to the

Office Action assertion, Li illustrates and recites “[i]t can be appreciated that due to the helical groove 70 [on the rotor body 40 outer surface] and guide pin 72 or guide screw 74 arrangement, the rotor body 40 will rotate through a predetermined number turns and will travel axially.” (Office Action, page 3; Li, column 6, lines 13-17). In brief, Applicant cannot find in Li any recitation of the guide interacting with the first portion of the fixation helix as claimed; rather, Li recites interaction between the guide and the rotor body (i.e., the asserted piston).

In view of the fact that not all elements and/or limitations of Applicant’s claim 15 can be found in Li, Applicant respectfully requests withdrawal of this basis of rejection of claim 15.

Claim 16:

In addition to the foregoing grounds set forth supporting the patentability of Applicant’s claims 15-17 (of which claim 16 is included), Applicant cannot find in the cited portions of Li a lead assembly “wherein the active fixation helix is electrically coupled with the piston,” as recited in claim 16. To this end, Applicant hereby incorporates by references the relevant arguments submitted above with respect to claims 14 and 15, as applied to Li (i.e., Li recites an electrical coupling between an electrical conductor and an electrical sleeve, but does not appear to recite an electrical coupling between the rotor body and the conductor or the fixation helix and the conductor as claimed; Li further does not appear to recite that the rotor body comprises an electrically conductive material allowing for an electrical coupling to be made with the same).

In view of the fact that not all elements and/or limitations of Applicant’s claim 16 can be found in Li, Applicant respectfully requests withdrawal of this basis of rejection of claim 16.

Claim 17:

In addition to the foregoing grounds set forth supporting the patentability of Applicant’s claims 15-17 (of which claim 17 is included), Applicant cannot find in the cited portions of Li a lead assembly “wherein the active fixation helix is recessed within an outer axial surface portion of the piston,” as recited in claim 17. Rather, Li recites “[t]he fixing helix 18 is secured on a distal end of the rotor body 40.” (Column 5, lines 40-41; *see also* FIGS. 2-4).

In view of the fact that not all elements and/or limitations of Applicant’s claim 17 can be found in Li, Applicant respectfully requests withdrawal of this basis of rejection of claim 17.

Claims 1-6 (In Light of Bisping):

Applicant submits that not all of the elements and/or limitations of claims 1-6 can be found in the cited reference (Bisping), as required by *W.L. Gore & Associates*.

Claim 1:

Applicant cannot find in the cited portions of Bisping, “[a] lead assembly comprising . . . a fixation helix supported by the piston at a first portion of the fixation helix, the first portion of the fixation helix supported by the piston forming a drive mechanism including one or more helical drive grooves; and a housing portion disposed near the distal end of the lead body, the housing portion including a guide disposed on an inner surface thereof and rideable within the helical drive grooves allowing at least one of advancing or retracting of the fixation helix relative to the lead body,” as recited in claim 1. Rather, Bisping recites “an electrode lead, a helix protruding at the end of the electrode lead near the heart for screwing the electrode into cardiac tissue, and a protective device protruding beyond the front end of the helix, during insertion of the electrode.” (Abstract). The Office Action asserts that the protective device comprises the claimed piston; however, Applicant submits that the protective device of Bisping does not support the fixation helix as claimed, but rather is movable with respect to the fixation helix. (Office Action, page 4; *see e.g.*, column 4, lines 2-6 reciting “the physician implanting the electrode can exert a pulling force in the direction of arrow 15 from that end of the protective core 3 to retract it and to remove it from the area 14 of the helix so as to permit fastening of the electrode”).

Additionally, Applicant submits the helix of Bisping is stationary relative to the lead body. (*See, e.g.*, column 6, lines 18-20; Abstract; FIGS. 1-7). Accordingly, (1) the asserted guide 24 of Bisping is not rideable within the helical drive grooves as claimed by Applicant, and (2) the helix is not allowed to advance or retract relative to the lead body as further claimed by Applicant.

In view of the fact that not all elements and/or limitations of Applicant’s claim 1 can be found in Bisping, Applicant respectfully requests withdrawal of this basis of rejection of claim 1. Claims 2-6 are dependent on claim 1 and are patentable over Bisping for the reasons stated above, in addition to the elements and/or limitations in such claims.

Claim 5:

In addition to the foregoing grounds set forth supporting the patentability of Applicant's claims 1-6 (of which claim 5 is included), Applicant cannot find in the cited portions of Bisping a lead assembly "wherein the recess has a first width and the first width is less than a diameter of the first portion of the fixation helix," as recited in claim 5. The Office Action asserts the claimed subject matter may be found in column 5, lines 42-44; however, the Applicants submits that such citation recites the ability of the protective core to deform upon removal from the helix, but does not recite a recess width less than a helix diameter as claimed.

In view of the fact that not all elements and/or limitations of Applicant's claim 5 can be found in Bisping, Applicant respectfully requests withdrawal of this basis of rejection of claim 5.

Claims 8-9 and 11-14 (In Light of Bisping):

Applicant submits that not all of the elements and/or limitations of claims 8-9 and 11-14 can be found in the cited reference (Bisping), as required by *W.L. Gore & Associates*.

Claim 8:

Applicant cannot find in the cited portions of Bisping, "[a] lead assembly comprising . . . a fixation helix coupled with the piston along a first longitudinal portion of the fixation helix, the first portion of the fixation helix coupled with the piston forming a drive mechanism that rides along the guide allowing at least one of advancing or retracting of the fixation helix relative to the lead body," as recited in claim 8. To this end, Applicant hereby incorporates by reference the relevant arguments asserted above with respect to claim 1, as applied to Bisping (i.e., the helix of Bisping is stationary relative to the lead body and therefore, the asserted guide of Bisping is not rideable within the drive mechanism allowing at least one of advancing or retracting of the helix relative to the lead body as claimed).

In view of the fact that not all elements and/or limitations of Applicant's claim 8 can be found in Bisping, Applicant respectfully requests withdrawal of this basis of rejection of claim 8. Claims 9 and 11-14 are dependent on claim 8 and are patentable over Bisping for the reasons stated above, in addition to the elements and/or limitations in such claims.

Claims 19-23 (In Light of Bisping):

Applicant submits that not all of the elements and/or limitations of claims 19-23 can be found in the cited reference (Bisping), as required by *W.L. Gore & Associates*.

Claim 19:

Applicant cannot find in the cited portions of Bisping, “[a] method comprising: providing a lead assembly including . . . a fixation helix supported by the piston at a first portion of the fixation helix supported by the piston, the first portion of the fixation helix forming a drive mechanism; . . . rotating the fixation helix; and longitudinally driving the fixation helix with the drive mechanism, including moving portions of the fixation helix along the guide,” as recited in claim 19. To this end, Applicant hereby incorporates by reference the relevant arguments asserted above with respect to claim 1, as applied to Bisping (i.e., the protective device/core of Bisping does not support the helix as claimed; the helix of Bisping is stationary relative to the lead body such that the first portion of the helix contacting the protective core is not able to ride along the guide within the housing as claimed).

In view of the fact that not all elements and/or limitations of Applicant’s claim 19 can be found in Bisping, Applicant respectfully requests withdrawal of this basis of rejection of claim 19. Claims 20-23 are dependent on claim 19 and are patentable over Bisping for the reasons stated above, in addition to the elements and/or limitations in such claims.

§103 Rejection of the Claims

Claims 15-18 and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bisping (U.S. Patent No. 4,282,885) and in view of Li (U.S. Patent No. 5,259,395). Claim 24 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Li (U.S. Patent No. 5,259,395) or Bisping (U.S. Patent No. 4,282,885) as applied to claim 1 above, and in view of Berthelsen et al. (U.S. Patent No. 5,002,067). Applicant respectfully traverses such rejections.

To establish a case of obviousness, three criteria must be met.

First, there must be some suggestion or motivation, either in the cited reference(s), or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. M.P.E.P. § 2142 (citing *In re Vaack*, 947 F.2d 488, 20 USPQ2d

(BNA) 1438 (Fed. Cir. 1991)). According to *In re Lee*, “there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant.” 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002)(citing *In re Fine*).

“We do not ‘pick and choose among the individual elements of assorted prior art references to recreate the claimed invention,’ but rather, we look for ‘some teaching or suggestion in the references to support their use in the particular claimed combination.’” *Symbol Technologies, Inc. v. Opticon, Inc.*, 935 F.2d 1569, 19 U.S.P.Q.2d 1241 (Fed. Cir. 1991).

A factor cutting against a finding of motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230 U.S.P.Q. 416 (Fed. Cir. 1986).

Second, the prior art reference(s) must teach or suggest all of the claim elements and/or limitations. M.P.E.P. § 2142.

Third, there must be a reasonable expectation of success. M.P.E.P. § 2142.

Claims 15-18 and 26 (In Light of Bisping and Li):

Applicant submits that not all of the elements and/or limitations of claims 15-18 and 26 can be found in the cited references (Bisping and Li) individually or in combination, as required by M.P.E.P. § 2142, and further submit that no legally sufficient motivation to combine Bisping and Li has been provided, as required by *In re Lee*.

Claim 15:

Among other things, Applicant cannot find in the cited portions of Bisping nor Li “[a] lead assembly comprising . . . a piston electrically coupled with the conductor; . . . and a housing including a guide therein, the guide extending from an inner surface of the housing and adapted to interact with the first portion of the fixation helix,” as recited in claim 15. To this end, Applicant first incorporates by reference the relevant arguments submitted above with respect to claim 15, as applied to Li (i.e., Li does not recite an electrical coupling between the conductor and the rotor body as claimed; the asserted guide of Li does not interact with the asserted first

portion of the helix as claimed), and claim 1, as applied to Bisping (i.e., the helix of Bisping is stationary relative to the lead body and the asserted first portion of the helix protrudes out the end of the lead body such that the first portion is not able to interact with the asserted guide as claimed).

Despite the foregoing, the Office Action asserts “it would have been obvious to one of ordinary skill in the art . . . to have modified the invention of Bisping to include a piston [that] is electrically coupled with a conductor, as taught by Li to ensure improved delivery of therapy to a patient.” (Office Action, page 6). As submitted above, Li does not appear to recite an electrical coupling between the conductor and the rotor body, thereby negating the Office Action’s asserted motivation to combine.

Further, Applicant submits that the asserted motivation to combine Bisping and Li (i.e., to ensure improved delivery of therapy to a patient) runs afoul with recitations of Bisping. For instance, Bisping recites “exert[ing] a pulling force in the direction of arrow 15 from that end of the protective core [i.e., the asserted piston] to retract it and to remove it from the area 14 of the helix so as to permit fastening of the electrode.” (Column 4, lines 2-6). Applicant submits that retraction of the protective core and improving delivery of therapy via electrical coupling between the protective core and the conductor appear to be at odds. Further yet, Applicant submits that the asserted motivation to combine Bisping and Li is an unsupported assertion, as prohibited by *In re Lee*. It is respectfully submitted that the above-identified assertion amounts to a form of Official Notice, which is timely traversed herein under M.P.E.P. § 2144.03, and if the Examiner is aware of a reference providing support for the assertion, citation of such reference is respectfully requested. If a reference cannot be provided, Applicant submits the assertion is formed on the personal knowledge of the Examiner, and Applicant respectfully requests that an affidavit is provided, as required by 37 C.F.R. § 1.104(d), or removal of this basis of rejection.

In view of the fact that neither Bisping nor Li teaches or suggests all of the subject matter of Applicant’s claim 15, and further because no legally sufficient motivation to combine such references has been provided, Applicant respectfully requests withdrawal of this basis of rejection of claim 15. Claims 16-18 and 26 are dependent on claim 15 and are patentable over

Bisping and Li for the reasons stated above, in addition to the elements and/or limitations in such claims.

Claim 16:

In addition to the foregoing grounds set for supporting the patentability of Applicant's claims 15-18 and 26 (of which claim 16 is included), Applicant cannot find in the cited portions of Bisping nor Li a lead assembly "wherein the active fixation helix is electrically coupled with the piston," as recited in claim 16. To this end, Applicant first incorporates by reference the relevant arguments submitted above with respect to claims 14 and 15, as applied to Li (i.e., Li recites an electrical coupling between an electrical conductor and an electrical sleeve, but does not appear to recite an electrical coupling between the rotor body and the conductor or the fixation helix and the conductor as claimed; Li further does not appear to recite that the rotor body comprises an electrically conductive material allowing for an electrical coupling to be made with the same).

Despite the foregoing, the Office Action asserts "it would have been obvious to one of ordinary skill in the art . . . to have modified the invention of Bisping to include an active fixation helix [that] is electrically coupled with a piston." (Office Action, pages 6-7). As submitted above, Li does not recite an electrical coupling between the rotor body and the conductor or the fixation helix and the conductor. Furthermore, Li does not recite that the rotor body comprises an electrically conductive material allowing for an electrical coupling to be made with the same. Further yet, Applicant submits that the asserted motivation to combine Bisping and Li (i.e., to ensure improved delivery of therapy to a patient) runs afoul with recitations of Bisping and is an unsupported assertion, as prohibited by *In re Lee*. To this end, Applicant hereby incorporates by reference the relevant arguments and request asserted above with respect to claim 15.

In view of the fact that neither Bisping nor Li teaches or suggests all of the subject matter of Applicant's claim 16, and further because no legally sufficient motivation to combine such references has been provided, Applicant respectfully requests withdrawal of this basis of rejection of claim 16.

Claim 24 (In Light of Li or Bisping and Berthelsen):

Applicant submits that no legally sufficient motivation to combine Li or Bisping with the teachings of Berthelsen et al. has been provided, as required by *In re Lee*.

Claim 24:

The Office Action recognizes that neither Bisping nor Li disclose a “housing portion compris[ing] a molded component,” as recited in claim 24; however, asserts that “Berthelsen et al. disclose[s] a housing portion compris[ing] a molded component . . . [and that] it would have been obvious to one of ordinary skill in the art . . . to have modified the invention of Li or Bisping to include a housing portion compris[ing] a molded component, as taught by Berthelsen et al. to improve lead strength and integrity during implantation and subsequent therapy delivery.” (Office Action, page 7).

The Office Action appears to pick and choose among individual elements of assorted references (i.e., Li, Bisping, and Berthelsen) to recreate the claimed invention without some teaching or motivation in the references to support their use in the particular claimed combination, as prohibited by *Symbol Technologies, Inc.* 935 F.2d 1569. Motivation to combine requires desirability, not merely a trade-off. *Winner International Royalty Corp.*, 202 F.3d 1340. To reiterate, the Office Action asserts that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the invention of Li . . . as taught by Berthelsen to improve lead strength and integrity during implantation and subsequent therapy delivery.” (Office Action, page 7). Applicant points out that Li recites “[a] counterbore 64 is provided to accommodate the relatively large diameter stylet which is used during implantation of the lead 14 through, for example, a vein, such [a]s in the case of the stylet 26 of FIG. 1. The relatively large diameter stylet provides rigidity to the lead 14 to thereby assist in the placement of the distal end of the lead 14 adjacent to the position at which it will be attached to body tissue.” (Column 4, lines 54-61). That is to say, Li recites a lead system providing rigidity for implantation via a stylet. Accordingly, Applicant submits the Office Action’s asserted motivation includes one or more mere trade-offs, not desirability as required by *Winner International Royalty Corp.*

In view of the fact that no legally sufficient motivation to combine Li, Bisping, and Berthelsen has been provided, Applicant respectfully requests withdrawal of this basis of rejection of claim 24.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 359-3276 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 3 day of October 2006.

Name

Signature